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REMARKS

Claims 1-2, 4-8, 10, 13, 16, 19, 22, 24-27, 29-33, 35, 38, 41, 44, 47, 49-50, 51-52, 54-66, and 68-71 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Catron *et al.* (U.S. Patent No. 5,018,191). As will be shown below, Catron, does not anticipate transferring a call to a backup according to call context as claimed in the present application. Claims 1-2, 4-8, 10, 13, 16, 19, 22, 24-27, 29-33, 35, 38, 41, 44, 47, 49-50, 51-52, 54-66, and 68-71 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1-2, 4-8, 10, 13, 16, 19, 22, 24-27, 29-33, 35, 38, 41, 44, 47, 49-50, 51-52, 54-66, and 68-71.

Claims 3, 9, 11-12, 14-15, 17-18, 20-21, 23, 28, 34, 36-37, 39-40, 42-43, 45-46, 48, and 67 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over combinations of Catron, *et al.* (U.S. Patent No. 5,018,191), Kung, *et al.* (U.S. Patent No. 6,373,817), Slusky, *et al.* (U.S. Patent No. 5,487,111), and Hou, *et al.* (EP 0585004). As will be shown below, neither Catron alone nor in combination with Kung, Slusky, or Hou teaches a method, system, or computer program product for transferring a call to a backup according to call context as claimed in the present application. Claims 3, 9, 11-12, 14-15, 17-18, 20-21, 23, 28, 34, 36-37, 39-40, 42-43, 45-46, 48, and 67 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 3, 9, 11-12, 14-15, 17-18, 20-21, 23, 28, 34, 36-37, 39-40, 42-43, 45-46, 48, and 67.

The Office Action fails to provide any reference in the rejection of claim 53. Applicants therefore respectfully traverse the rejection of claim 53 and request reconsideration of claim 53.

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Claim Rejections – 35 U.S.C. §102 Over Catron

Claims 1-2, 4-8, 10, 13, 16, 19, 22, 24-27, 29-33, 35, 38, 41, 44, 47, 49-50, 51-52, 54-66, and 68-71 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Catron, *et al.* (U.S. Patent No. 5,018,191). To anticipate claims 1-2, 4-8, 10, 13, 16, 19, 22, 24-27, 29-33, 35, 38, 41, 44, 47, 49-50, 51-52, 54-66, and 68-71 under 35 U.S.C. § 102(b), two basic requirements must be met. The first requirement of anticipation is that Catron must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that Catron must enable Applicants' claims. Catron does not meet either requirement and therefore does not anticipate Applicants' claims.

Catron Does Not Disclose Each and Every Element
Of The Claims Of The Present Application

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As explained in more detail below, Catron does not disclose each and every element of independent claims 1, 26, 51, 62, 70, and 71, and Catron therefore cannot be said to anticipate the claims of the present application within the meaning of 35 U.S.C. § 102.

Regarding claim 1, the Office Action states that column 3, lines 21-23, and column 2, lines 21-34, of Catron disclose "detecting a context for a call from a caller to an intended callee...." What Catron at column 3, lines 21-23, actually discloses is "recognizing fax calls by a special prefix or an indicator in a data message from customer equipment...." Catron does not disclose detecting a context, a caller, an intended callee, or any other limitation of claim 1. Catron's recognizing fax calls by a special prefix or an indicator is not detecting a context for a call from a caller to an intended callee as claimed in the present application.

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What Catron at column 2, lines 21-34, actually discloses is that a "fax caller may dial a conventional (voice) telephone station line and have that call connected automatically to a fax machine serving that station line instead of its telephone." The intended callee of Catron is a fax machine. The fax caller of Catron never places a call to the intended callee—the fax machine. The caller of Catron instead places a call to a party not intended to receive the call—a voice line. Because a fax caller cannot communicate with a party on a voice line, a voice line cannot be an intended callee. Catron's fax caller dialing a conventional voice telephone station line is not detecting a context for a call from a caller to an intended callee as claimed in the present application.

Further with regard to claim 1, the Office Action states that column 6, lines 45-60, and column 10, lines 1-2, of Catron disclose:

automatically selecting at least one backup party from among a plurality of backup parties to said intended party according to said context for said call....

What Catron at column 6, lines 45-60, and column 10, lines 1-2, actually discloses is a database in which:

a translation is made from a called number such as 254 to a pointer such as 264 which points to a block of memory 280. This block includes a number of alternative destinations 281, 282, according to the time and/or day of week 284, 285.

The alternative destinations of Catron are not call backups as claimed in the present application. Depending on the time or day of week, one of the destinations listed in Catron's database serves as a routing endpoint of a fax call to a voice line. That is, the destination fax numbers in Catron's database are alternatives only in so far as they alternate as destinations, intended first destinations, not backup destinations, depending on the time or day of week. The destinations of Catron referred to in the Office Action

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serve merely as intended fax routing destinations for a fax caller to a voice line. The destinations of Catron therefore do not serve as call backups within the meaning of the claims in the present of the present application. The database containing a number of destinations according to the time or day of week of Catron is not automatically selecting at least one backup party from among a plurality of backup parties to said intended party according to said context for said call as claimed in the present application.

Regarding claim 26, the Office Action states that elements 156 and 250 from Figure 1 of Catron disclose "a context inference service server communicatively connected to a trusted telephone network...." What Catron at column 5, lines 67-68, regarding element 156 actually discloses is that "Processor 156 of switch 150, operative under the control of program 157, examines message 140...." Catron at column 5, lines 48-49, states that message 140 "is sent for any call recognized a being a fax call...." Element 156 of Catron therefore does not determine whether a call is a fax call, but instead merely examines message 140 of Catron's Figure 1. Regardless whether processor 156 determined whether a call was a fax call, determining whether a call is a fax call is not inferring a call context as claimed in the present application. Element 250 of Catron merely discloses a database containing telephone numbers to which fax calls are translated. Element 250 therefore does not infer a call context. The processor and database of Catron does not disclose a context inference service server communicatively connected to a trusted telephone network as claimed in the present application.

Regarding claim 62, Applicants recite the first element of claim 62 as "receiving a call request for a call at a service provider...." If the first element, or any single element, of claim 62 is not anticipated, then claim 62 is patentable because a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The Office Action does not provide any reference regarding the anticipation of the first element of claim 62. That is, the office action makes no attempt to demonstrate that the first element of claim 62 is anticipated, either expressly or inherently described, in any prior art reference. Moreover, Applicants

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respectfully submit that nothing in the prior art teaches this claim limitation. Claim 62 therefore is patentable and should be allowed.

Further regarding claim 62, Applicants recite the second element as "accessing a context for said call, wherein said context comprises at least one context based backup party for said call...." Because the Office Action does not provide any reference regarding the anticipation of the second element of claim 62, the Office Action makes no attempt to demonstrate that the second element of claim 62 is anticipated, either expressly or inherently described, in any prior art reference. Applicants respectfully submit that nothing in the prior art teaches this claim limitation. Claim 62 therefore is patentable and should be allowed.

Regarding claim 62, the Office Actions states that column 2, lines 17-19, of Catron discloses:

responsive to detecting that said call is unanswered, automatically transferring said call to said at least one context based backup party for said call...

What Catron at column 2, lines 17-19, actually discloses is an "automatic conversion of a conventional fax call to a store and forward call on busy or on ring-no-answer condition." Catron's store and forward facility stores a call for later forwarding to the original intended callee. Explaining the function of its call and forward facility, Catron at column 1, lines 45-50, states:

Advances in fax service now enable a customer encountering a busy or ring-no-answer condition on a fax call to send a facsimile message to a store and forward facility for subsequent transmission to the destination facsimile machine when that facsimile machine is available.

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Because Catron's store and forward facility merely stores a fax for later "forwarding" to the same originally intended callee facsimile machine when the callee machine becomes available, the call is not transferred to a backup party. That is, the original destination facsimile machine of Catron is not a backup party. The conversion of a fax call to a store and forward facility of Catron therefore does not disclose automatically transferring a call to at least one context based backup party for the call as claimed in the present application.

Regarding claim 70, Applicants recite the first element of claim 70 as "receiving a call request for a call to an intended callee...." If the first element, or any single element, of claim 70 is not anticipated, then claim 70 is patentable because a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The Office Action does not provide any reference regarding the anticipation of the first element of claim 70. That is, the office action makes no attempt to demonstrate that the first element of claim 70 is anticipated, either expressly or inherently described, in any prior art reference. Moreover, Applicants respectfully submit that nothing in the prior art teaches this claim limitation. Claim 70 therefore is patentable and should be allowed.

Further regarding claim 70, Applicants recite the second element as follows:

accessing a context for said call, wherein said context comprises a request to automatically forward said call to a context based backup party for said intended callee...

Because the Office Action does not provide any reference regarding the anticipation of the second element of claim 70, the Office Action makes no attempt to demonstrate that the second element of claim 70 is anticipated, either expressly or inherently described, in any prior art reference. Applicants respectfully submit that nothing in the prior art teaches this claim limitation. Claim 70 therefore is patentable and should be allowed.

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Further regarding claim 70, the Office Action states that column 6, lines 54-56, of Catron discloses "forwarding said call to said context based backup party...." What Catron at column 6, lines 54-56, actually discloses is "a store and forward facility 180 for automatically storing the facsimile message for subsequent delivery." The store and forward facility of Catron, as mentioned above, merely stores the fax for later 'forwarding' to the same intended callee. Catron's store and forward facility that merely stores the fax for later 'forwarding' to the same intended callee does not disclose forwarding a call to a context based backup party as claimed in the present application.

Regarding claim 71, Applicants recite the first element as "receiving an identification of at least one backup party for an intended callee requested by a caller utilizing a telephony device...." Because the Office Action does not provide any reference regarding the anticipation of the first element of claim 71, the Office Action makes no attempt to demonstrate that the first element of claim 71 is anticipated, either expressly or inherently described, in any prior art reference. Applicants respectfully submit that nothing in the prior art teaches this claim limitation. Claim 71 therefore is patentable and should be allowed.

Further regarding claim 71, Applicants recite the second element as "controlling output of said identification of said at least one backup party via an output interface accessible to said telephony device...." Because the Office Action does not provide any reference regarding the anticipation of the second element of claim 71, the Office Action makes no attempt to demonstrate that the second element of claim 71 is anticipated, either expressly or inherently described, in any prior art reference. Applicants respectfully submit that nothing in the prior art teaches this claim limitation. Claim 71 therefore is patentable and should be allowed.

Still further regarding claim 71, the Office Action states that claim 71 is rejected for the same reason as claim 25. Regarding claim 25, the office action states, "Claim 25 reads, for example, on the fax call being processed based on the ANI of the called party (or 'identity of said intended callee')." The Office Action's description of the rejection for

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claim 71 does not give the Applicants inadequate notification of the reasons for the rejection. 35 U.S.C. § 132 requires the Examiner to notify the applicants of the reasons for a rejection, including "such information and references as may be useful in judging of the propriety of continuing the prosecution...." 37 C.F.R. § 1.104(c)(2) second sentence requires, "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable." MPEP § 707 requires, when needed for compliance with 35 U.S.C. § 132, the inclusion in the Office Action of "...the particular figures(s) of the drawing(s), and/or page(s) or paragraph(s) of the reference(s)...." In this Office Action, the statement, "Claim 25 reads, for example, on the fax call being processed based on the ANI of the called party (or 'identity of said intended callee')." is accompanied by no explanation of where in Catron the Examiner relies or to which element the statement applies. Without having a proper reference or explanation for the rejection, the Applicants cannot understand the basis for the rejection. The rejection therefore fails to meet the requirements of 35 U.S.C. § 132 and should be withdrawn.

Although it is unclear from the wording of the Office Action, Applicants take the Examiners words regarding claim 25 as a reference to the following element of claim 71:

responsive to receiving a selection from among said at least one backup party, transferring said call to a switch providing service for said selected backup party....

In the absence of a proper reference according to 35 U.S.C. § 132, Applicants are under no obligation to respond further to the rejection of claim 71. Nevertheless, in a conscientious effort to advance the case, Applicants respectfully point out that the call processing claimed in claim 71 is processing that transfers a call to a backup party. The processing cited against claim 71 is processing a call 'based on the ANI of the called party', that is, the intended callee, not a backup party. The processing cited against claim 71 therefore cannot be said to anticipate, suggest, or disclose the call processing claimed in claim 71.

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Catron Does Not Enable Each and Every Element
Of The Claims Of The Present Application

Not only must Catron disclose each and every element of the claims of the present application within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also Catron must be an enabling disclosure of each and every element of the claims of the present application within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the applicant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless Catron places Applicants' claims in the possession of a person of ordinary skill in the art, Catron is legally insufficient to anticipate Applicants' claims under 35 U.S.C. § 102(b).

Catron in fact does not place each and every element of independent claims 1, 26, 51, 62, 70, and 71 in the possession of a person of skill in the art. Regarding claim 1, the Office Action states that column 3, lines 21-23, and column 2, lines 21-34, of Catron disclose "detecting a context for a call from a caller to an intended callee...." What Catron at column 3, lines 21-23, actually discloses is "recognizing fax calls by a special prefix or an indicator in a data message from customer equipment...." Catron does not disclose detecting a context, a caller, an intended callee, or any other limitation of claim 1. Catron's recognizing fax calls by a special prefix or an indicator does not place in the possession of a person of skill in the art detecting a context for a call from a caller to an intended callee as claimed in the present application.

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What Catron at column 2, lines 21-34, actually discloses is that a "fax caller may dial a conventional (voice) telephone station line and have that call connected automatically to a fax machine serving that station line instead of its telephone." The intended callee of Catron is a fax machine. The fax caller of Catron never places a call to the intended callee—the fax machine. The caller of Catron instead places a call to a party not intended to receive the call—a voice line. Because a fax caller cannot communicate with a party on a voice line, a voice line cannot be an intended callee. Catron's fax caller dialing a conventional voice telephone station line does not place in the possession of a person of skill in the art detecting a context for a call from a caller to an intended callee as claimed in the present application.

Further with regard to claim 1, the Office Action states that column 6, lines 45-60, and column 10, lines 1-2, of Catron disclose:

automatically selecting at least one backup party from among a plurality of backup parties to said intended party according to said context for said call....

What Catron at column 6, lines 45-60, and column 10, lines 1-2, actually discloses is a database in which:

a translation is made from a called number such as 254 to a pointer such as 264 which points to a block of memory 280. This block includes a number of alternative destinations 281, 282, according to the time and/or day of week 284, 285.

The alternative destinations of Catron are not call backups as claimed in the present application. Depending on the time or day of week, one of the destinations listed in Catron's database serves as a routing endpoint of a fax call to a voice line. That is, the destination fax numbers in Catron's database are alternatives only in so far as they alternate as destinations, intended first destinations, not backup destinations, depending

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on the time or day of week. The destinations of Catron referred to in the Office Action serve merely as intended fax routing destinations for a fax caller to a voice line. The destinations of Catron therefore do not serve as call backups within the meaning of the claims in the present of the present application. The database containing a number of destinations according to the time or day of week of Catron does not place in the possession of a person of skill in the art automatically selecting at least one backup party from among a plurality of backup parties to said intended party according to said context for said call as claimed in the present application.

Regarding claim 26, the Office Action states that elements 156 and 250 from Figure 1 of Catron disclose "a context inference service server communicatively connected to a trusted telephone network...." What Catron at column 5, lines 67-68, regarding element 156 actually discloses is that "Processor 156 of switch 150, operative under the control of program 157, examines message 140...." Catron at column 5, lines 48-49, states that message 140 "is sent for any call recognized a being a fax call...." Element 156 of Catron therefore does not determine whether a call is a fax call, but instead merely examines message 140 of Catron's Figure 1. Regardless whether processor 156 determined whether a call was a fax call, determining whether a call is a fax call is not inferring a call context as claimed in the present application. Element 250 of Catron merely discloses a database containing telephone numbers to which fax calls are translated. Element 250 therefore does not infer a call context. The processor and database of Catron do not place in the possession of a person of skill in the art a context inference service server communicatively connected to a trusted telephone network as claimed in the present application.

Regarding claim 62, Applicants recite the first element of claim 62 as "receiving a call request for a call at a service provider...." If the first element, or any single element, of claim 62 is not anticipated, then claim 62 is patentable because a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The Office Action does not provide any reference regarding the anticipation of the first element of claim 62. That is, the office

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action makes no attempt to demonstrate that the first element of claim 62 is anticipated, either expressly or inherently described, in any prior art reference. Moreover, Applicants respectfully submit that nothing in the prior art places in the possession of a person of skill in the art this claim limitation. Claim 62 therefore is patentable and should be allowed.

Further regarding claim 62, Applicants recite the second element as "accessing a context for said call, wherein said context comprises at least one context based backup party for said call...." Because the Office Action does not provide any reference regarding the anticipation of the second element of claim 62, the Office Action makes no attempt to demonstrate that the second element of claim 62 is anticipated, either expressly or inherently described, in any prior art reference. Applicants respectfully submit that nothing in the prior art places in the possession of a person of skill in the art this claim limitation. Claim 62 therefore is patentable and should be allowed.

Regarding claim 62, the Office Actions states that column 2, lines 17-19, of Catron discloses:

responsive to detecting that said call is unanswered, automatically transferring said call to said at least one context based backup party for said call...

What Catron at column 2, lines 17-19, actually discloses is an "automatic conversion of a conventional fax call to a store and forward call on busy or on ring-no-answer condition." Catron's store and forward facility stores a call for later forwarding to the original intended callee. Explaining the function of its call and forward facility, Catron at column 1, lines 45-50, states:

Advances in fax service now enable a customer encountering a busy or ring-no-answer condition on a fax call to send a facsimile message to a

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store and forward facility for subsequent transmission to the destination facsimile machine when that facsimile machine is available.

Because Catron's store and forward facility merely stores a fax for later "forwarding" to the same originally intended callee facsimile machine when the callee machine becomes available, the call is not transferred to a backup party. That is, the original destination facsimile machine of Catron is not a backup party. The conversion of a fax call to a store and forward facility of Catron therefore does not place in the possession of a person of skill in the art automatically transferring a call to at least one context based backup party for the call as claimed in the present application.

Regarding claim 70, Applicants recite the first element of claim 70 as "receiving a call request for a call to an intended callee...." If the first element, or any single element, of claim 70 is not anticipated, then claim 70 is patentable because a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The Office Action does not provide any reference regarding the anticipation of the first element of claim 70. That is, the office action makes no attempt to demonstrate that the first element of claim 70 is anticipated, either expressly or inherently described, in any prior art reference. Moreover, Applicants respectfully submit that nothing in the prior art places in the possession of a person of skill in the art this claim limitation. Claim 70 therefore is patentable and should be allowed.

Further regarding claim 70, Applicants recite the second element as follows:

accessing a context for said call, wherein said context comprises a request to automatically forward said call to a context based backup party for said intended callee...

Because the Office Action does not provide any reference regarding the anticipation of the second element of claim 70, the Office Action makes no attempt to demonstrate that

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the second element of claim 70 is anticipated, either expressly or inherently described, in any prior art reference. Applicants respectfully submit that nothing in the prior art places in the possession of a person of skill in the art this claim limitation. Claim 70 therefore is patentable and should be allowed.

Further regarding claim 70, the Office Action states that column 6, lines 54-56, of Catron discloses "forwarding said call to said context based backup party...." What Catron at column 6, lines 54-56, actually discloses is "a store and forward facility 180 for automatically storing the facsimile message for subsequent delivery." The store and forward facility of Catron, as mentioned above, merely stores the fax for later 'forwarding' to the same intended callee. Catron's store and forward facility that merely stores the fax for later 'forwarding' to the same intended callee does not place in the possession of a person of skill in the art forwarding a call to a context based backup party as claimed in the present application.

Regarding claim 71, Applicants recite the first element as "receiving an identification of at least one backup party for an intended callee requested by a caller utilizing a telephony device...." Because the Office Action does not provide any reference regarding the anticipation of the first element of claim 71, the Office Action makes no attempt to demonstrate that the first element of claim 71 is anticipated, either expressly or inherently described, in any prior art reference. Applicants respectfully submit that nothing in the prior art places in the possession of a person of skill in the art this claim limitation. Claim 71 therefore is patentable and should be allowed.

Further regarding claim 71, Applicants recite the second element as "controlling output of said identification of said at least one backup party via an output interface accessible to said telephony device...." Because the Office Action does not provide any reference regarding the anticipation of the second element of claim 71, the Office Action makes no attempt to demonstrate that the second element of claim 71 is anticipated, either expressly or inherently described, in any prior art reference. Applicants respectfully submit that

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nothing in the prior art places in the possession of a person of skill in the art this claim limitation. Claim 71 therefore is patentable and should be allowed.

Still further regarding claim 71, the Office Action states that claim 71 is rejected for the same reason as claim 25. Regarding claim 25, the office action states, "Claim 25 reads, for example, on the fax call being processed based on the ANI of the called party (or 'identity of said intended callee')." The Office Action's description of the rejection for claim 71 does not give the Applicants inadequate notification of the reasons for the rejection. 35 U.S.C. § 132 requires the Examiner to notify the applicants of the reasons for a rejection, including "such information and references as may be useful in judging of the propriety of continuing the prosecution...." 37 C.F.R. § 1.104(c)(2) second sentence requires, "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable." MPEP § 707 requires, when needed for compliance with 35 U.S.C. § 132, the inclusion in the Office Action of "...the particular figure(s) of the drawing(s), and/or page(s) or paragraph(s) of the reference(s)..." In this Office Action, the statement, "Claim 25 reads, for example, on the fax call being processed based on the ANI of the called party (or 'identity of said intended callee')." is accompanied by no explanation of where in Catron the Examiner relies or to which element the statement applies. Without having a proper reference or explanation for the rejection, the Applicants cannot understand the basis for the rejection. The rejection therefore fails to meet the requirements of 35 U.S.C. § 132 and should be withdrawn.

Although it is unclear from the wording of the Office Action, Applicants take the Examiners words regarding claim 25 as a reference to the following element of claim 71:

responsive to receiving a selection from among said at least one backup party, transferring said call to a switch providing service for said selected backup party....

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In the absence of a proper reference according to 35 U.S.C. § 132, Applicants are under no obligation to respond further to the rejection of claim 71. Nevertheless, in a conscientious effort to advance the case, Applicants respectfully point out that the call processing claimed in claim 71 is processing that transfers a call to a backup party. The processing cited against claim 71 is processing a call 'based on the ANI of the called party', that is, the intended callee, not a backup party. The processing cited against claim 71 therefore cannot be said to place in the possession of a person of skill in the art the call processing claimed in claim 71.

Catron neither teaches nor enables all the element and limitation of independent claims 1, 26, 51, 62, 70, and 71. Independent claims 1, 26, 51, 62, 70, and 71 are therefore patentable and should be allowed. Depended claims 2, 4-8, 10, 13, 16, 19, 22, 24-25, 27, 29-33, 35, 38, 41, 44, 47, 49-50, 52, 54-61, 63-66, and 68-69 depend from independent claims 1, 26, 51, and 62. Dependent claims 2, 4-8, 10, 13, 16, 19, 22, 24-25, 27, 29-33, 35, 38, 41, 44, 47, 49-50, 52, 54-61, 63-66, and 68-69 include each and every limitation of the independent claims from which they depend. Dependent claims 2, 4-8, 10, 13, 16, 19, 22, 24-25, 27, 29-33, 35, 38, 41, 44, 47, 49-50, 52, 54-61, 63-66, and 68-69 stand because their respective independent claims stand. Catron therefore does not anticipate Applicants' claims 1-2, 4-8, 10, 13, 16, 19, 22, 24-27, 29-33, 35, 38, 41, 44, 47, 49-50, 51-52, 54-66, and 68-71 within the meaning of 35 U.S.C § 102(b).

Claim Rejections – 35 U.S.C. § 103

Claims 3, 9, 11-12, 14-15, 17-18, 20-21, 23, 28, 34, 36-37, 39-40, 42-43, 45-46, 48, and 67 stand rejected under 35 U.S.C § 103(a) as unpatentable over combinations of Catron, *et al.* (U.S. Patent No. 5,018,191), Kung, *et al.* (U.S. Patent No. 6,373,817), Slusky, *et al.* (U.S. Patent No. 5,487,111), and Hou, *et al.* (EP 0585004). Applicants respectfully traverse each rejection. To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* § 2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a

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suggestion or motivation to combine the references. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of the references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

Catron, Alone or in Combination, with Kung,
Slusky, or Hou Does Not Teach all Of Applicants' Claim Limitations

As shown above, Catron fails to disclose each and every element of independent claims 1, 26, 51, 62, 70, and 71. Catron, alone or in combination, with Kung, Slusky, or Hou therefore fails to disclose each and every element of dependent claims 3, 9, 11-12, 14-15, 17-18, 20-21, 23, 28, 34, 36-37, 39-40, 42-43, 45-46, 48, and 67 because the Office Action only cites Catron as teaching the claim limitations found in independent claims 1, 26, 51, 62, 70, and 71. Catron, alone or in combination, with Kung, Slusky, or Hou therefore cannot disclose each and every element of the referenced dependent claims. The Office Action therefore fails to make a prima facie case for obviousness under 35 U.S.C. § 103. The rejections of claims 3, 9, 11-12, 14-15, 17-18, 20-21, 23, 28, 34, 36-37, 39-40, 42-43, 45-46, 48, and 67 under 35 U.S.C. § 103 are improper and should be withdrawn.

No Suggestion or Motivation to Modify Catron,
Alone or in Combination with Kung, Slusky, or Hou

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify Catron, alone or in combination with Kung, Slusky, or Hou. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to modify Catron, alone or in combination with Kung, Slusky, or Hou, must come from the

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teaching of Catron, Kung, Slusky, or Hou themselves, and the Examiner must explicitly point to the teaching within Catron, Kung, Slusky, or Hou suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action makes no mention whatsoever of any place in any of the references that suggests or provides any motivation for the proposed modification of Catron, alone or in combination, with Kung, Slusky, or Hou. Absent such a showing, the Examiner has impermissibly used hindsight occasioned by Applicants' own teaching to reject the claims. Because the Office Action fails to make a prima facie case for obviousness under 35 U.S.C. § 103, the rejections of claims 3, 9, 11-12, 14-15, 17-18, 20-21, 23, 28, 34, 36-37, 39-40, 42-43, 45-46, 48, and 67 are improper and should be withdrawn.

No Reasonable Expectation of Success in the Proposed
Modification of Catron, Alone or in Combination
with Kung, Slusky, or Hou

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed modification of Catron, alone or in combination, with Kung, Slusky, or Hou. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). There can be no reasonable expectation of success in a proposed modification if the proposed modification changes the principle of operation of Catron, Kung, Slusky, or Hou. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The Office Action makes no mention whatsoever of any place in any of the references that suggests or provides any reasonable expectation of success in the proposed modification of Catron, alone or in combination, with Kung, Slusky, or Hou. Absent

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such a showing, the Office Action fails to make a prima facie case for obviousness under 35 U.S.C. § 103. The rejections of claims 3, 9, 11-12, 14-15, 17-18, 20-21, 23, 28, 34, 36-37, 39-40, 42-43, 45-46, 48, and 67 are improper and should be withdrawn.

Neither Catron alone nor in combination with Kung, Slusky, or Hou discloses each and every element of claims 3, 9, 11-12, 14-15, 17-18, 20-21, 23, 28, 34, 36-37, 39-40, 42-43, 45-46, 48, and 67. There is no suggestion to modify Catron, alone or in combination with Kung, Slusky, or Hou, and there is no reasonable expectation of success in the proposed modification of Catron. The Office Action therefore does not establish a prima facie case of obviousness under 35 U.S.C. § 103. Applicants respectfully traverse the rejection to each of claims 3, 9, 11-12, 14-15, 17-18, 20-21, 23, 28, 34, 36-37, 39-40, 42-43, 45-46, 48, and 67 and request that the claims be allowed.

The Office Action Fails To Provide Any Reference
In The Rejection of Claim 53

Regarding claim 53, the Office Action does not provide any reference that anticipates or makes obvious all the elements and limitations of claim 53. For the convenience of the Examiner, Applicants reproduce claim 53 below:

53. The computer program product for determining a call backup according to claim 51, further comprising:

means, recorded on said recording medium, for detecting a context for said call at a context inference service executing within said trusted telephone network handling said call.

A rejection under 35 U.S.C. § 102 requires that each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). To establish a prima facie case of obviousness under 35 U.S.C. §

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103, the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The Office Action does not provide any reference regarding the anticipation or obviousness of any element of claim 53. That is, the office action makes no attempt to either demonstrate that any element of claim 53 is anticipated, either expressly or inherently described, in any prior art reference or propose a combination of references that teaches or suggests all of the Applicants' limitations of claim 53. Moreover, Applicants respectfully submit that nothing in the prior art anticipates or makes obvious claim 53. Claim 53 therefore is patentable and should be allowed.

Relations Among Claims

Independent claims 26 and 51 claim system and computer program product aspects of the method claimed in claim 1. Claims 26 and 51 therefore are patentable for the same reasons that claim 1 is patentable as described above. Dependent claims 2-25, 27-50 and 52-61 depend respectively from independent claims 1, 26, and 51. The dependent claims include each and every limitation of the independent claims from which they depend. The dependent claims stand because their respective independent claims stand.

Independent claims 62, 70, and 71 claim method aspects of the invention. Dependent claims 63-69 depend from independent claim 62. The dependent claims include each and every limitation of the independent claims from which they depend. The dependent claims stand because their respective independent claims stand.

Conclusion

Claims 1-2, 4-8, 10, 13, 16, 19, 22, 24-27, 29-33, 35, 38, 41, 44, 47, 49-50, 51-52, 54-66, and 68-71 stand rejected under 35 U.S.C § 102(b) as being anticipated by Catron. Catron does not disclose each and every element of Applicants' independent claims 1, 26, 51, 62, 70, and 71, and Catron does not enable Applicants' independent claims 1, 26, 51, 62, 70, and 71. Depended claims 2, 4-8, 10, 13, 16, 19, 22, 24-25, 27, 29-33, 35, 38, 41, 44, 47,

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49-50, 52, 54-61, 63-66, and 68-69 depend from independent claims 1, 26, 51, and 62. Dependent claims 2, 4-8, 10, 13, 16, 19, 22, 24-25, 27, 29-33, 35, 38, 41, 44, 47, 49-50, 52, 54-61, 63-66, and 68-69 include each and every limitation of the independent claims from which they depend. Dependent claims 2, 4-8, 10, 13, 16, 19, 22, 24-25, 27, 29-33, 35, 38, 41, 44, 47, 49-50, 52, 54-61, 63-66, and 68-69 stand because their respective independent claims stand. Catron therefore does not anticipate Applicants' claims 1-2, 4-8, 10, 13, 16, 19, 22, 24-27, 29-33, 35, 38, 41, 44, 47, 49-50, 51-52, 54-66, and 68-71 within the meaning of 35 U.S.C. § 102(b). Claims 3, 9, 11-12, 14-15, 17-18, 20-21, 23, 28, 34, 36-37, 39-40, 42-43, 45-46, 48, and 67 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over combinations of Catron, *et al.* (U.S. Patent No. 5,018,191), Kung, *et al.* (U.S. Patent No. 6,373,817), Slusky, *et al.* (U.S. Patent No. 5,487,111), and Hou, *et al.* (EP 0585004). Neither Catron alone nor any proposed combination establishes a prima facie case of obviousness. In rejecting claim 53, the Office Action fails to provide any reference in the rejection of claim 53. The rejection of all claims 1-71 in the present case should therefore be withdrawn, and the claims should be allowed. Applicants respectfully traverse each rejection individually of claims 1-71 and request reconsideration of claims 1-71 in light of the present remarks.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

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